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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/626,376	07/24/2003	Robert S. Greeff	57226-A-RE	2506
7590	07/28/2006		EXAMINER	
Peter J Phillips Cooper & Dunham LLP 1185 Avenue of the Americas New York, NY 10036			LAVINDER, JACK W	
			ART UNIT	PAPER NUMBER
				3677

DATE MAILED: 07/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/626,376	GREEFF, ROBERT S.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jack W. Lavinder	3677	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 16 June 2006.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-23 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-23 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                     | Paper No(s)/Mail Date. _____ .  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____ .                                  |

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-3 and 21 have been rejected under 35 U.S.C. 102(b) as being anticipated by Rosenberg, D389425.

Regarding claims 1-3, 21, Rosenberg, D389425, discloses a “mixed-cut” gemstone having a crown formed with “step-cut” facets and a pavilion formed with “brilliant-cut” facets, i.e. facets radiating from the center culet (bottom point in figure 7) of the stone towards the girdle (figures 5-8). The stone has four corners wherein the corner length is less than the length of the two sides of the stone (top and bottom sides in figures 5 and 8). The pavilion of the stone is defined by eight or more substantially straight rib lines extending from the girdle to the culet (figure 8).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 4-20 and 22-23 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Rosenberg in view of the Octo-Square Briliant reference.

Regarding claims 4-8, 12-14, 16-20, and 22-23, Rosenberg discloses three and four facets along the rib lines, but fails to disclose only two facets along the rib lines. Rosenberg also discloses that two of the pavilion sides have three facets and the other two sides have six facets. The courts have noted that matters relating to ornamentation only, which have no mechanical function, cannot be relied upon to patentably distinguish the claimed invention from the prior art. *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947). The Octo-Square Brilliant reference shows a pavilion with eight rib lines and only two facets per rib line as an alternative design choice for cutting the pavilion. Furthermore, the number of facets on the sides or corners is a matter of design choice, because it only changes the look of the stone. There is no asserted utility or criticality to the number of facets or shape of the facets on the pavilion of the stone. It would have been an obvious design choice to only have two facets along the rib lines of Rosenberg's gemstone in order to change the look of the gemstone to make it more appealing to wearer's of the gemstone.

Regarding claims 9 and 15, Rosenberg also discloses that each pavilion side and corner extends entirely to the culet.

Regarding claim 10, Rosenberg also discloses that the pavilion is devoid of any facet intersection lines parallel with the girdle.

Regarding claim 11, Rosenberg discloses each pavilion side and corner has a facet with a facet corner at the culet.

The examiner would like to point out that applicant is merely claiming the shape of the gemstone for ornamental purposes. The courts have noted that a change in

shape would be obvious to a person having ordinary skill in the art absent any teachings of unexpected results or criticality of the shape. Furthermore, as stated above, the courts have also noted that matters relating to ornamentation only, which have no mechanical function, cannot be relied upon to patentably distinguish the claimed invention from the prior art. *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947). Therefore, the shape of the gemstone and the number of facets on the pavilion rib lines, sides or corners are for ornamental purposes only. The disclosure and the remarks from applicant have failed to set forth any unexpected results from the shape, number, size and/or orientation of the pavilion facets on the gemstone, such as, the fire, color or brilliance of the stone has been magnified by tenfold. This hasn't been shown or disclosed. Therefore, it is concluded that the shape of the gemstone and the number of facets on the pavilion rib lines, sides or corners are for ornamental purposes only and according to the courts cannot patentability distinguish over the prior art.

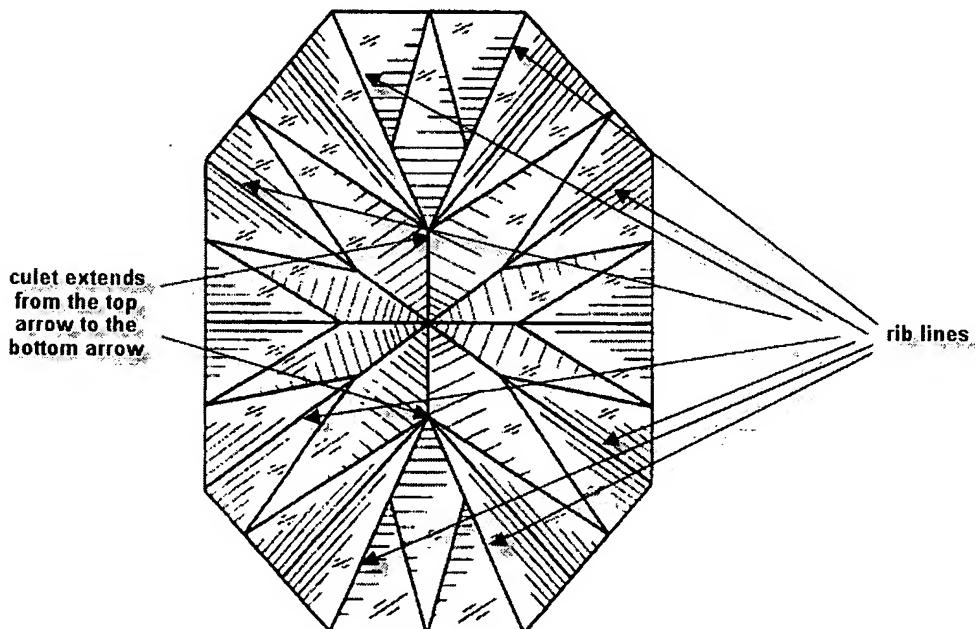
#### ***Response to Arguments***

5. Applicant's arguments filed 6/19/2006 have been fully considered but they are not persuasive. The applicant states that the "claim language should be construed to mean that each corner (of the four corners) is less than the side length (of each of the four sides)." (page 1, paragraph 4 of remarks). The examiner's interpretation of the claim language is reasonable and is not required to be narrowly construed as suggested by the applicant. Although one may interpret the language as suggested by the applicant in their remarks, one may also interpret the language as the set forth by the examiner in this action and the previous action. If applicant's intent is to claim that all

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the side lengths of the gemstone are equal and that the corner lengths are less than the side lengths of the stone, please amend the claim in order to better define what the applicant's invention covers. Otherwise, the claims have been given their broadest reasonable interpretation and the Rosenberg reference meets the limitations of the claim based on the examiner's interpretation of the claim language.

The applicant argues that the eight rib lines in the pavilion of the stone do not extend in a straight line to the culet. Figure 8 of Rosenberg shows eight rib lines extending in a straight line from the girdle to the culet.



The applicant argues that the combination of Rosenberg with the Octo-Square Brilliant reference is improper: one would not be motivated to pick and choose features from one and combine those features with the other. The

examiner disagrees. One of ordinary skill in the art would be motivated to combine features from one gemstone to another in order to beautify the gemstone. The beauty of the gemstone is in the eye of the beholder. Therefore, any features from any of the gemstones available in the prior art are fair game to the designer, because the designer is trying to create a unique, beautifully cut gemstone.

The examiner is of the opinion that claims directed to the type of cut facets, the number of cut facets, the shape of the cut facets, the orientation of the cut facets, the location of the cut facets are all directed to ornamenting the gemstone. It has been well settled in the prior art that certain angles and facets between the crown and the pavilion increase the fire, brilliance, clarity and beauty of a gemstone. Therefore, in order to patentably distinguish applicant's gemstone over the prior art gemstones, the applicant must prove that their facet arrangement produces some unexpected result in the areas of brilliance, fire, or clarity of the stone. Otherwise, it is concluded that the arrangement of the facets on the gemstone are for ornamental purposes only—there are no other benefits or mechanical functions being provided by the applicant's facet arrangement.

### ***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

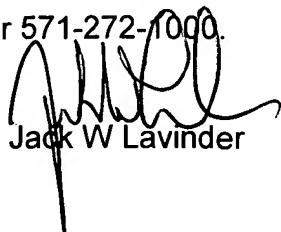
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack W. Lavinder whose telephone number is 571-272-7119. The examiner can normally be reached on Mon-Friday, 9-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Swann can be reached on 571-272-7075. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Jack W Lavinder

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Primary Examiner  
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7/17/2006